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E. Miller



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Elizabeth Miller  
Elizabeth. Miller

Oct. 2, 2002  
Date

ATTY DOCKET NO. 10010760-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Glenda C. Delenstarr et al. Group Art Unit: 1634

Serial No.: 09/899,381

Examiner: Bradley L. Sisson

Filed: 07/02/2001

Title: ARRAYS HAVING BACKGROUD FEATURES AND METHODS  
FOR USING THE SAME

Commissioner for Patents  
Washington, D.C. 20231

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OCT 15 2002

Dear Sir:

TECH CENTER 1600/2900

RESPONSE TO RESTRICTION

The Examiner is thanked for the Office Action 09/03/2002 (restriction requirement only). The Examiner identified the following Groups:

Group I: claims 1-12 for an array; and  
Group II: claims 13-23 for a method.

First it is noted that the application as filed contained claims 1-27 all of which are believed to be still pending. Claims 24-27 are claims for a kit.

Applicants hereby elect Group II (claims 13-23) with traverse. In particular, M.P.E.P 803 requires that

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

In the present case the only independent claim in Group II is claim 13. This claim is a method claim which requires in part:

- “(a) providing a nucleic acid array comprising:
  - (i) at least one hybridization feature to which said analyte nucleic acid specifically binds under stringent hybridization conditions; and
  - (ii) at least one background feature;” (emphasis added)

The broadest claim of Group I, claim 1, recites an array comprising:

- “(a) at least one hybridization feature; and
- (b) at least one background feature”

Claim 13 then requires providing an array of the type of claim 1. Thus, in order to search and examine claims of the type of Group II the Examiner must necessarily search and examine claims of a type of Group I. That being the case, there is no “serious burden” on the Examiner in searching and examining Group I together with Group II.

It is not clear what restriction requirement, if any, the Examiner might make with regard to the kit claims 24-27. However, given that the only independent claim of these claims also requires a kit having the same elements of claim 1, there is again no “serious burden” on the Examiner in searching and examining these claims together with those of Groups II and I.

If the Examiner is of the view that there are any outstanding issues that might be resolved by means of a telephone conference, he is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



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